

# Memorandum

---

**To:** Mr. Le

**From:** Kimberly Johnson

**Date:** 7/31/02

**Re:** Litigation search request 5,991,542

Attached please find the results of your litigation search. Please feel free to contact me if you have additional questions or concerns. Thank you and have a great day.

Kimberly Johnson

TIS

EIC 2600

305-4071



**MEMO TO EXAMINER**

Reissue 09/990,887 (US Patent 5,991,542)

**Note:** All claims must be examined. There is no presumption of validity attached to the claims which were previously issued in the parent. Applicant has surrendered the claims in the filing of the Reissue application. The following cited points correspond to the items listed in the checklist and are provided as an aid to the reissue examination process. Please retain this note in the file wrapper to expedite the review process after allowance. Please remember to wand all cases (particularly the issued parent) so that they can be located.

(Item 1) Please <sup>review</sup> ~~order~~ the parent file 08/713,500 and ~~review~~ its prosecution history prior to issuing an office action. Please retain the parent file with you and upon allowance of the reissue application, return the parent file with the reissue application for final review by the SPRE.

(Item 7) The litigation history for 5,991,542 has been ordered and is attached herewith. Please review them carefully and take appropriate action as outlined in the Reissue Guide.

(Item 8/9) The patent (or reissue application) has been assigned. Please check to see if the assignee consent to the filing of the reissue application pursuant to 37 CFR § 1.172. If not, please check to see if there's a petition filed pursuant to MPEP 1410.01 for a waiver of the requirement of Rule 1.172.

(Item 11) Please review the reissue application for presence of any errors, including any not specifically identified. Be aware of errors which may not be corrected by the reissue. See the attached Reissue Guide for the types of errors that may exist.

(Item 12/13) With respect to new claims 21-30, if they are broader in any respect to the patented claim, recapture must be considered. The issue of new matter also must be considered for the amended claim. No amendments may introduce new matter as set out in 35 USC 251 and as cited in 37 CFR 1.173. Examiner should reference item 13 in the Reissue Guideline for better understanding of "recapture" issues.

(Item 14) Applicants have not offered to surrender original Patent. The original ribboned copy of the patent must be surrendered prior to allowance. Please point this out in your office action so that the prosecution can be expedited. Again, the original patent, or a statement addressing the loss or inaccessibility of the original patent, must be received before the reissue application can be allowed.

(Item 17) Drawings filed with the reissue application should be considered formal and must be reviewed by the draftsman.

(Item 18) Reissue oath or declaration must comply with all the requirements of 37 CFR § 1.63 and 1.175. There are new claims presented. Please check if the oath/declaration addresses these changes. See the Reissue Guide for guidance.

(Item 21) Please make sure the manner of making reissue amendments is in full compliance with 37 CFR 1.173(b). See Reissue Guide for guidance.

**(Misc)** Please make sure that every reference listed in the Original Patent is also cited either on a PTO-892 or PTO-1449 prior to allowance.

Return this memo and attach the parent file(s) to the reissue application when submitting the action for review. Any question(s) should be directed to the SPRE office.

Vu Le  
AU 2613  
703-308-6613  
SPRE Detail

Query/Command : prt max legalall

---

1 / 1 PLUSPAT - ©QUESTEL-ORBIT

PN - US5991542 A 19991123 [US5991542]  
TI - (A) Storage volume handling system which utilizes disk images  
PA - (A) APPLE COMPUTER (US)  
IN - (A) HAN BYRON B (US); KATELEY JAMES F (US); MURPHY COLM (IE);  
FITZGERALD-SMITH KENNETH (IE)  
AP - US71350096 19960913 [1996US-0713500]  
PR - US71350096 19960913 [1996US-0713500]  
IC - (A) G06F-015/16  
PCL - ORIGINAL (O) : 717167000  
DT - Basic  
CT - US4864572; US5001628; US5179378; US5230052; US5298992; US5325532; US5353061;  
US5363487; US5367698; US5374916; US5394534; US5426645; US5452454; US5493649;  
US5504842; US5555416; US5604906; US5778384; US5838910  
STG - (A) United States patent  
AB - Disk images, and the like, are used to emulate storage volumes for the distribution of computer software. An image of a data storage volume, such as a hard disk drive, is stored in a file having a format that enables it to exhibit a behavior which is the same as the storage volume itself. The image files are accessed by means of an associated driver which can support a variety of different file system protocols, thereby permitting the files themselves to be independent of the format requirements of particular file systems. The data in the image file can be compressed in a manner such that a storage volume being emulated appears to be of a specified size, while actually requiring less space to store its contents. With these properties, the image files can be mounted in the manner of a hardware storage device, and large files can be readily transmitted and downloaded in an electronic format. Since the files are preserved in their original form, end-to-end verification remains possible, to ensure the integrity of the downloaded files. Multiple images can be combined into a single tome, for installation at a remote site using a one-button approach.

---

1 / 1 LGST - ©LEGSTAT

PN - US 5991542 [US5991542]  
AP - US 713500/96 19960913 [1996US-0713500]  
DT - US-P  
ACT - 19960913 US/AE-A  
APPLICATION DATA (PATENT)  
US 713500/96 19960913 [1996US-0713500]  
  
19991123 US/A  
PATENT  
  
20010417 US/CC  
CERTIFICATE OF CORRECTION

20020528 US/RF  
REISSUE APPLICATION FILED  
20011121

UP - 2002-24

---

*1 / 1 CRXX - ©CLAIMS/RRX*

PN - 5,991,542 A 19991123 [US5991542]  
PA - Apple Computer Inc  
ACT - 20011121 REISSUE REQUESTED  
ISSUE DATE OF O.G.: 20020528  
REISSUE REQUEST NUMBER: 09/990887  
EXAMINATION GROUP RESPONSIBLE FOR REISSUEPROCESS: 2652

Reissue Patent Number:

---

*1 / 2 PAST - ©Thomson Derwent*

AN - 200222-001902  
PN - 5991542 A [US5991542]  
OG - 2002-05-28  
ACT - REISSUE APPLICATION FILED

---

*2 / 2 PAST - ©Thomson Derwent*

AN - 200116-000130  
PN - 5991542 A [US5991542]  
OG - 2001-04-17  
ACT - CERTIFICATE OF CORRECTION